

Allergan Docket No. 17171CIP4DIV (AP)  
Serial No. 09/685,828; Filed October 10, 2000

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### REMARKS

All of the rejections to the present application which were made in previous Office Actions have been withdrawn in the Final Rejection with the exception of the rejection of claims 21-25, 33, and 39 under 35 USC 112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention." In a telephonic interview with Examiner, new wording was agreed to for independent claim 21, which is presented herein as claim 44 and has substantial changes relative to the original form. However, these changes were merely made to improve clarity and do not constitute a narrowing amendment. After that amendment the claim had the following wording:

A method for determining whether a compound is an inverse agonist of a nuclear receptor comprising the steps:

- c) contacting a polypeptide comprising a ligand binding region and a ligand dependent transactivation region of said nuclear receptor with a test compound in the presence of a reporter gene, wherein the expression of said reporter gene is sensitive to stimulation by said nuclear receptor in the presence of an agonist of said nuclear receptor; and
- d) determining the ability said polypeptide to stimulate expression of said reporter gene in the presence of said test compound as compared to the ability of said polypeptide to stimulate expression of said reporter gene in the basal state, said basal state occurring in the absence of a ligand of said nuclear receptor,

wherein repression of the ability of said polypeptide to stimulate expression of said reporter gene in the presence of the test compound relative to the basal state according to step b indicates that the test compound is an inverse agonist.

It then came to Applicants attention that the election as to the species "retinoid" in claim 21 per the restriction requirement of the first Office Action had been overlooked in the response to the first Office Action. At this point, Applicant could have simply filed the amendment using the claim as shown above, waited for Examiner to require the election be made in the claim, and then file a response. In order to expedite the allowance of the elected material, the election is made in the claims as presented herein. Applicants reserve the right to prosecute all non-elected species in a separate application, and do not surrender to the public any of the disclosure covered in claim 21 as filed.

It is Applicants position that no narrowing amendments have been made for a substantial reason related to patentability.

Claim 22 is deleted as it is unnecessary in light of the restriction requirement.

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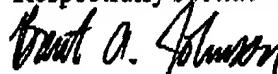
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Claims 45-46 are claims 23-24, rewritten to depend only upon one claim, since both were originally dependent upon the cancelled claim 22.

Claim 47 is claim 25 represented to depend upon claim 44 instead of 21.

In light of the amendments made herein Applicants assert that all of the claims meet the statutory requirements for patentability, and therefore respectfully request that the Examiner remove the rejections and pass the application to issue.

Respectfully submitted,



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